Remarks

The foregoing amendments in the specification and claims are of formal nature, and do not add new matter.

Claims 2-10, 16, 17 and 19-23 are pending in this application. The amendments and remarks presented herein are believed to be fully responsive to the Office Action.

Claim Objections

Claims 2 and 16 were amended as requested by the Examiner.

Claim Rejections 35 U.S.C. § 112, Second Paragraph

Claims 21 and 22 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner noted that "Applicant does not teach introduction of Agrobacterium tumefaciens into a tomato tissue." Without acquiescing to the Examiner's position in the current rejection, Applicants submit that the amendment of Claims 21 and 22 renders the rejection of this claim moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of the present rejection.

Claim Rejections 35 U.S.C. § 112, First Paragraph

Claims 2 and 19 are rejected under 35 U.S.C. § 112, first paragraph, because the Examiner alleges that "the claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention" and that "Applicant does not describe the function of the identified fragments, nor does Applicant describe other "genes" that produce a desired trait."

The Applicants respectfully traverse the Examiner's argument. The claimed gene constructs are characterized by functional features that produce a variety of desired traits in fruit-bearing plants (page 4 lines 10-21). Applicants have also defined what is meant by "heterologous" gene constructs on page 6, lines 33-39 and have provided teachings on isolation of genes of interest in the Examples provided. Furthermore, as the MPEP states, "The fact that experimentation may be complex does not necessarily make it undue, if the art engages in such experimentation" *In re Certain Limited-charge cell Culture*

Microcarriers, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'. sub nom., Massuchusetts Institute of Technology v A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985) M.P.E.P. 2164.01. Accordingly, Applicants respectfully request reconsideration and withdrawal of the present rejection.

Claim Rejections 35 U.S.C. § 102

Claims 8-10, 17 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Jones *et al.* (1994) taken with the evidence of Jones et al (1992). The Examiner alleges that the maize transposon Activator (Ac) of Jones et al., acts as an enhancer of gene expression and thus meets the limitation of the claims. However, Jones et al teaches an activator, not an enhancer.

Again, for a proper rejection under 35 U.S.C. § 102, the cited prior reference must disclose every element of the claimed invention. Claim 20, recites: "...transforming cells of a tomato plant with a plant cell expression vector having an *E. coli* origin of replication, ***an enhancer***..." (emphasis added). With respect to the enhancer element, the Examiner states "the terms 'enhance' and 'enhancer' are subjective. One of skill in the art at the time of Applicant's invention would work as an enhancer, if the transposon functioned to disrupt a repressor region....". Applicants respectfully disagree with the Examiner's rationale. Contrary to the Examiner's assertion, the term "enhancer" is not subjective, but rather has a well-defined meaning within the art of transgenic plants and refers to a DNA regulatory sequence that influences transcription of a structural gene (see attached Exhibit A). Jones et al. (1994) do not disclose a plant cell expression vector that comprises an enhancer.

Therefore, Applicants respectfully submit that Jones et al. is not prior art under 102(b). Accordingly, the Examiner is respectfully requested to reconsider and withdraw the present rejection.

Claim Rejections 35 U.S.C. § 103

Claims 2-10, 16, 17, and 19-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Walden *et al.* 1994 in view of Jones *et al.* 1992. Applicants have previously argued that Walden *et al.* is a review article summarizing studies that reportedly show the successful use of activation tagging in tomato to identify genes implicated in plant growth and development, but that the various publications by the Walden *et al.* lab relating to these results were subsequently retracted (see Applicant's response filed August 6, 2001). The Examiner alleges the retraction was directed to the function of the identified

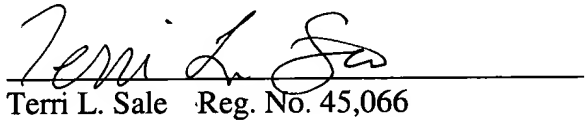
gene and does not obviate the teachings of Walden et al as it is directed to the use of promoter tagging to identify desired trait genes. [Emphasis added].

The Applicants respectfully traverse the Examiner's argument. First, Walden et al teaches the selection of cells for growth due to the presence of an activated gene. Walden does not teach the creation of transgenic plants and then screening those plants for phenotypes that are due to gene activation, which is disclosed by the present invention. Second, the Examiner stated that Walden et al taught promoter insertion, not the use of an enhancer as claimed in the present invention. The Examiner relies on Jones for teaching transposon tagging in tomato, and that the method functions similarly in tobacco and tomato. Again, given the inadequacies of the Walden *et al.* reference, one skilled in the art would not have had a reasonable expectation of success from the combined teachings of Walden *et al.* and Jones *et al.* that activation tagging would be successful in tomato.

For these reasons, the rejections under 35 U.S.C. § 103 should be withdrawn.

Respectfully submitted,

Dated: October 21, 2005



Terri L. Sale Reg. No. 45,066

EXELIXIS, INC.
170 Harbor Way, P.O. Box 511
South San Francisco, California 94083-0511
Telephone: (650) 837-7460
Facsimile: (650) 837-7179